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Mark Ehlman Scuderi

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EXAMINER

BOZADJIAN, GEORGE D

ART UNIT

PAPER NUMBER

1762

MAIL DATE

DELIVERY MODE

09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,047

Applicant(s)

SCUDERI ET AL.

Examiner

George D. Bozadjian

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment has been acknowledged from attorney James G. McEwen, attorney for applicants.

Specification

2. Applicant states, in Paragraph 0003, that U.S. Patent No. 5,323,299 is directed to a washer. This appears to be a typo because U.S. Patent No. 5,323,299 is not directed to washers.

The amended disclosure is objected to because of the following informalities: U.S. Patent 4,323,165 is directed to “Bottle Closure” and not to washing/cleaning units, or anything related to applicants’ case.

Appropriate correction is required.

The amendment filed July 18, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant amended the original referenced patent by canceling it and writing a new reference number instead. The new reference was not originally in the disclosure of the specification and therefore, it was not supported by the specification as originally filed. The new reference is U.S. Patent 4,323,165 – page 2, Parag. 0003, line 5 of the amended response.

Applicant is required to cancel the new matter in the reply to this Office Action.

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3. The disclosure is objected to because of the following informalities: the numbered label for shelf 770 [Parag. 0034, line 6] needs to be replaced to shelf 170 to match the rest of the numbering system in the specification and the figures for that specific part.

Appropriate correction is required.

The correction was received on July 18, 2007. The corrected numbered part is acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "dry wound filter" in claim 7 is not clear to one of ordinary skill in the art. It is not described in the specification nor in prior arts searched. For the purposes of applying art, the term has been interpreted as inclusive of any wound filter. Penguin Filter Pump Industries teaches many forms and types of wound cartridge filters [Bulletin 503C 11/98, and 501G 12/98], but does not teach "dry wound filter".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by Yamamoto (U.S. Patent 6,279,587, hereafter '587).

'587 teaches a washing and recycling system for use with removing paint from a coated article [Abstract], comprising:

a basin (12) in which the coated article is disposed [Fig. 1, col. 2, line 27];

a reservoir (20) connected to the basin (12) and which holds a solvent (22) which removes the paint from the coated article [col. 1, lines 22-26; Fig. 1, col. 2, lines 38-40];

a washing system (30, 31, 32, 34, 36, 40, 46, 48) which is connected to the reservoir (20) and to the basin (12) such that the solvent (22) from the reservoir (20) is moved past a first filter (32) to remove portions of the paint in the solvent (22), and the filtered solvent (22) is moved into the basin (12) so as to remove the paint from the coated article [Fig. 1, col. 2, lines 47-58; col. 3, lines 5-7];

a recycling system (122, 124, 126) which is connected to the reservoir (20) and to the basin (12) such that the solvent (22) from the reservoir (20) is moved past a second filter (122) [Fig 2, col. 5, lines 5-14] to remove portions of the paint in the solvent (22), and the filtered solvent (22) is moved into the basin (12) [col. 5, lines 12-14, 39-40; claim 17];

and

a control system (38, 42, 44, 82, 84, 85, 86, 88, 90, 92) which controls the washing system (30, 31, 32, 34, 36, 40, 46, 48) to supply filtered solvent (22) from the reservoir (20) to the basin (12) to remove the paint from the coated article during a washing operation, and which controls the recycling system (122, 124, 126) during a recycling

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operation to move the solvent (22) from the reservoir (20) to the basin (12) so as to maintain the solvent (22) [Fig. 2, col. 3, lines 64-67; col. 4, lines 1-6; col. 5, lines 14-21].

Claims 2-3: The apparatus in '587 is capable of handling any solvent which includes Hazardous Pollutants (HAPs) free, low VOCs (volatile organic compounds), non-flammable, non-toxic, non-carcinogenic, solvents [col. 2, lines 40-41] and biodegradable and water dilutable solvents designed for the removal of residual paints [col. 2, lines 40-41].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihringer (U.S. Patent 4,407,316, hereafter '316) in view of Yamamoto '587.

Claim 1 and 4: '316 teaches a washing and recycling system for use with removing paint from a coated article [Abstract], comprising:

a basin (1) in which the coated article is disposed [col. 1, lines 32-34, 63-67];

a reservoir (3) connected to the basin (1) and which holds a solvent which removes the paint from the coated article [col. 1, lines 32-36];

a washing system (starting from 3, directed by 4, via 21, through 2) which is connected to the reservoir (3) and to the basin (1) such that the solvent from the reservoir (3) is moved

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into the basin (1) so as to remove the paint from the coated article [col. 1, lines 32-40, lines 63-67; claim 1];

a recycling system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22) which is connected to the reservoir (3) [col. 1, lines 32-40; col. 2, lines 5-9; claim 1]; and

a control system (4) which controls the washing system (starting from 3, directed by 4, via 21, through 2) to supply... solvent from the reservoir (3) to the basin (1) to remove the paint from the coated article during the washing operation,... wherein the control system (4) further comprises a pump (4) which selectively moves the solvent from the reservoir (3) through the washing system (starting from 3, directed by 4, via 21, through 2) and the recycling system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22) [col. 1, lines 36-40, 63-67; col. 2, lines 2-9].

'316 teaches that the washing and recycling system uses a solvent to remove paint off of parts, after which the solvent is recycled and returned to the reservoir (3) to be re-used. It does not explicitly teach A) the washing system (starting from 3, directed by 4, via 21, through 2) and recycling system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22) each having its own filter, nor B) the recycle system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22) connected to the basin (1). However, '587 teaches that the washing system contains a conduit filter to remove particles over 2 to 3 mil [col. 2, lines 49-52]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed a filter in the washing system of '316 at the bottom of the reservoir (3) to have prevented particles over 2 to 3 mil from entering the

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washing system (starting from 3, directed by 4, via 21, through 2) and recycling system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22). '587 also teaches that the solvent recycling system could be a filtration system or a distillation system [col. 5, lines 39-40; claim 17]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the filtration system of '587 to have cleaned the recycle stream with a reasonable expectation of success, and in this case, to replace the distillation system in '316 with a filtration system (it is also obvious that filtration systems contain filters) because '587 teaches that it is a suitable system to treat used paint washing solvent for further uses. As for the recycle return conduit, '587 teaches that the recycle return conduit in parts washing systems can be connected directly to the basin [col. 5, lines 12-14]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the recycle return conduit connected to the basin because the solvent eventually drains into the reservoir, and '587 demonstrates that it was recognized as another suitable process arrangement.

Claims 2, 3, 10 and 11: '316 teaches that the washing and recycling system uses a water-miscible organic solvent (col. 2, line 5), but does not generalize on the solvent's characteristics. '587 teaches that all types of solvents can be used in the washing and recycling system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that these apparatuses could have operated using all kinds of solvents, Hazardous Pollutants (HAPs) free, low VOCs (volatile organic compounds), non-flammable, non-toxic, non-carcinogenic, solvents [col. 2, lines 40-41] and biodegradable and water dilutable solvents

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designed for the removal of residual paints [col. 2, lines 40-41], and that the unit's capabilities are not controlled by the type of solvent used.

10. Claims 8 and 9: '316 teaches that during the washing operation, the solvent passes through the washing system and that the washing system is other than recycling system. It does not teach controlling the solvent to pass through the first filter (located in the washing system) but to not pass through the second filter (recycling system). '587 teaches the obvious matter of placing the "first filter" in the washing system and the "second filter" in the recycling system (as described above). '587 also teaches the control system (38, 42, 44, 82, 84, 85, 86, 88, 90, 92) controlling the recycling apparatus (122; filtration system containing the second filter) to operate continuously or intermittently, that is, the recycling apparatus (122; filtration system containing the second filter) can operate whether or not the washing apparatus (30, 31, 32, 34, 36, 40, 46, 48) is operating to allow the user to appropriately control the recycling operation [col. 5, lines 40-48]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the control system of '587 in '316 in order to have allowed the user to appropriately control the recycling operation.

11. Claims 5, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over '316 in view of '587 as applied to claims 4 and 11 above, and further in view of Ozyjiwsky (U.S. Patent 5,107,876, hereafter '876).

'316 teaches the use of a pump (4) to move the solvent, but does not mention the driving force of the pump (4) [col. 1, line 36-40, 63-67]. '587 teaches that an air-driven (i.e. pneumatic) pump can be used in the system [col. 3, lines 1-4], but does not teach why. One of ordinary skill in the art would have recognized that it would have avoided the unnecessary feature of electrical

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power within the otherwise inflammable environment of the solvent containing and operating system ['876, col. 3, lines 14-18]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a pneumatic pump to have run the process in '316 in order to avoid the unnecessary feature of electrical power if inflammable solvents were used.

Claim 15: '316, '587 and '876 teach the limitations of claim 12 as stated above. '316 teaches the presence of nozzles (2) to clean the paint [col. 1, line 34]. It does not teach a brush used as part of the nozzles. However, '587 teaches solvent being supplied through a cleaning brush (60) [Fig. 1, col. 3, lines 12-13] to sweep, brush or otherwise remove solvent and paint from the coated article. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached a brush to a nozzle (2 in '316) in order to have swept, brushed or otherwise removed solvent and paint from the coated article.

12. Claims 6, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '316 in view of '587 as applied to claims 1 and 4 above, and further in view of Robb et al. (U.S. Patent 4,793,369, hereafter '369).

'316 and '587 teach a reservoir beneath the basin where the pump in '316 removes the solvent from the reservoir through the inlet. These two references do not teach a basin comprised of a grate and the inlet that removes the solvent from the reservoir. However, '369 teaches a parts washer where the reservoir is enclosed within the basin as a single unit. It also teaches the basin consisting of a mesh screen (50), which divides the basin into a work chamber separated from the reservoir, into which parts to be cleaned may be placed and also acts as a barrier for large paint chunks [col. 3, lines 47-51]. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to have placed the screen into the basin (1, in '316) in order to have used it as parts holder and to have filtered large chunks of paint.

Claim 16: '316 and '587 teach a washing and recycling system with a control system.

These two references do not teach the availability of compressed air passing through the air hose. '369 teaches the presence of an air hose (46) adapted to receive pressurized air from a compressor to control the amount of pressurized air needed to move the solvent throughout the looping system ['369, col. 3, lines 38-40; col. 6, lines 28-29]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the air hose and compressor to the control system (4 in '316) to have controlled the amount of pressurized air needed to move the solvent throughout the looping system.

Claim 20: The references do not explicitly teach a non-atomizing mount. '316 teaches the use of full jet, non-pulverizing nozzles [col. 1, lines 33-34] and '587 teaches its outlet tube (54) having an outlet nozzle (58) for directing solvent onto parts to be washed [col. 3, lines 10-12]. These two references do not teach the availability of a mount to mount on the painted parts. '369 teaches an outlet tube (60, 62, 74) that is used as a mount (60, 70a, 74, 80, 82; 62, 90, 92, 96, 98) to mount painted parts [Fig. 2, col. 3, lines 60-68; col. 4, line 1]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached these non-atomizing nozzles to the mount in order to have supported the painted parts in place and to have passed the solvent onto the painted parts, in a non-atomizing manner, as a suitable means to control the fluid path during the washing process.

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13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over ‘316 in view of ‘587 as applied to claim 4 above, and further in view of Penguin™ Filter Pump Industries (hereafter Penguin™ Ind.) and Perez et al. (U.S. Patent 5,947,057, hereafter ‘057).

‘316 and ‘587 teach the limitations of claim 4 as stated above. ‘316 teaches that the washing and recycling system uses a solvent to remove paint off of parts, after which the solvent is recycled and returned to the reservoir (3) to be re-used. It does not explicitly teach the washing system (starting from 3, directed by 4, via 21, through 2) and recycling system (starting from 3, directed by 4, via 6, through rest of downstream process, returning via 22) each having its own filter. ‘587 teaches that the washing system contains a conduit filter to remove particles over 2 to 3 mil [col. 2, lines 49-52], and also teaches that the solvent recycling system could be a filtration system [col. 5, lines 39-40; claim 17]. They do not teach the types of filters used. However, Penguin™ Ind. teaches the manufacture of a variety of wound type filter cartridges to remove different types and forms of impurities, including paints, from solvents [Natural Cotton Wound Filter Cartridge, Bulletin 501G, 12/1998, page 3]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the wound filter, of Penguin™ Ind., in the filtration system of ‘587 to have removed paints from solvents. ‘057 teaches the use of carbon filters (6, 15) to replenish untreated water and remove contaminants [col. 4, 15-17; col. 9, lines 39-43], where the carbon filters are placed at various places of the treatment process, including at the inlets [col. 6, lines 55-60]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the carbon filter in the carbon conduit of ‘587 to have removed the paint contaminants from the solvent.

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14. Claims 13, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over ‘316 in view of ‘587 and ‘876 as applied to claim 12 above, and further in view of ‘369.

‘316, ‘587 and ‘876 teach the limitations of claim 12 as stated above. ‘587 teaches the washing and recycling system having an outlet tube (54). They do not explicitly teach the presence of a gun mount. ‘369 teaches an outlet tube (62) that includes a stepped bore (92) used as a gun mount (62, 90, 92, 96, 98) to receive and support a paint gun (84) [Fig. 2, col. 3, lines 66-68; col. 4, line 1]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the gun mount (62, 90, 92, 96, 98), in ‘369, to the outlet tube (54) of ‘587 in order to have supplied solvent through the interior of the paint gun to have removed the paint.

Claim 14: ‘316, 587 and ‘876 teach the limitations of claim 12 as stated above. ‘587 teaches the washing and recycling system having an outlet tube (54). They do not explicitly teach the presence of a cup mount. ‘369 teaches an outlet tube (60, 74) with a spray head (80) which is used as a cup mount (60, 70a, 74, 80, 82) to place a cup (82) of a paint gun (84) [Fig. 2, col. 3, lines 60-66]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the cup mount (60, 70a, 74, 80, 82), in ‘369, to the outlet tube (54) of ‘587 in order to have mounted the cup and supplied the solvent through its interior to have removed paint.

Claim 17: ‘316, ‘587 and ‘876 teach the limitations of claim 12 as stated above. ‘316 and ‘587 teach a washing and recycling system with a control system. ‘587 also teaches an air-driven pump can be used [col. 3, lines 1-2]. These two references do not teach the availability of compressed air passing through the air hose, and a pneumatic pump receiving compressed air.

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However, '369 teaches the pump (40) includes an air hose (46) adapted to receive pressurized air from a compressor to control the amount of pressurized air the pump needed to move the solvent throughout the looping system ['369, col. 3, lines 38-40; col. 6, lines 28-29]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached a pneumatic pump (4 in '316) with its air hose and compressor to the control system (4 in '316) to have controlled the amount of pressurized air the pump needed to move the solvent throughout the looping system.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over '316 in view of '587 and '876 as applied to claim 12 above, and further in view of Magliocca (U.S. Patent 6,398,877, hereafter '877).

'316, '587 and '876 teach the limitations of claim 12 as stated above. '316 teaches the presence of a double-loop system where the pump ejects liquid into two separate circulation paths, but does not mention the presence of filters within paths. '587 teaches the presence of a filter in the washing system (30, 31, 32, 34, 36, 40, 46, 48) and the recycling system (122, 124, 126) [col. 2, lines 49-51; col. 5, lines 5-7, 39-40]. All three references do not mention the filter being removable. '877 teaches the filter being a replaceable filter that is periodically removed for disposal, and replaced with another replaceable filter [claim 4]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have these filters be removable filters in the washing system and recycling system of '316 so that it could be used to clean the paint-contaminated solvent and replaced after residue collected in them have clogged the system.

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16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over '316 in view of '587, '876 and '877 as applied to claim 18 above, and further in view of '369.

'316, '587 and '876 teach the limitations of claim 18 as stated above. '316 and '587 teach a reservoir beneath the basin where the pump in '316 removes the solvent from the reservoir through the inlet. These references do not teach a basin comprised of a grate and the inlet that removes the solvent from the reservoir. However, '369 teaches a parts washer where the reservoir is enclosed within the basin as a single unit. It also teaches the basin consisting of a mesh screen (50), which divides the basin into a work chamber separated from the reservoir, into which parts to be cleaned may be placed and also acts as a barrier for large paint chunks [col. 3, lines 47-51]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the screen into the basin (1, in '316) in order to have used it as parts holder and to have filtered large chunks of paint and to have made it a single unit with the reservoir, because '369 shows that such is a suitable configuration to collect and recycle solvent in a parts washing process.

Response to Arguments

17. Applicant's arguments filed July 18, 2007 have been fully considered but they are not persuasive.

a. Applicants argue "the examiner has not provided evidence as to how, ...one of ordinary skill in the art would not understand the metes and bounds of the recited "dry wound filter" as opposed to a wound filter".

Applicants' response did not address 35 U.S.C. 112, Second Paragraph rejection.

The term “dry wound filter”, as stated by the applicants, has not been defined in the disclosure of the specification. Further, the term “dry wound filter” has neither been defined in the “List Of References Cited By Applicant”, nor in the prior art searched and used by the examiner. Finally, the term “dry wound filter” has yet not been defined in the applicants’ response to the Non-Final Rejection. An art recognized definition, at the time or before applicants filing date, of the term “dry wound filter” would satisfy the requirement without adding new matter.

b. Applicants argue, regarding the reference of Yamamoto (U.S. 6,279,587), “... the parts washer 120 shown in FIG. 2 does not include the filter 32 shown in the parts washer 10 shown in FIG. 1”.

Figure 2 is an alternate arrangement of Figure 1 [col. 2, lines 18-20; col. 5, lines 1-5]. One of ordinary skill in the art would instantly envisage that filter 32 is also needed in FIG. 2, whether or not the individual draws it.

c. Applicants argue, regarding the reference of Yamamoto (U.S. 6,279,587), “... the control box 44 only controls the parts washer 10 of FIG. 1 as opposed to detachable recycling apparatus”.

Yamamoto teaches the detachable recycling apparatus is electronically connected to circuit board (85), which in turn is located in the control box (44), by a control cable (135) by connector (136) [Figs. 1-2; col. 5, lines 12-21].

d. Applicants argue claims 2 and 3 are not supported by Yamamoto (U.S. 6,279,587), and Ihringer (U.S. 4,407,316) in view of Yamamoto (U.S. 6,279,587).

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In response to applicants' argument that Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) do not teach the limitations of claims 2 and 3, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Therefore, Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) are capable of holding any solvents.

e. Applicants argue "... the combined teachings of Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) would not result in a washing system and recycling system having filters as recited in claim 1".

Ihringer (U.S. 4,407,316) specifies solvent is being used while washing the parts and does not have the difficulty as specified or assumed by the applicants. Examiner notes applicants point at [col. 1, lines 44-49] prior art Yamamoto (U.S. 6,279,587) is aiming to solve [col. 1, lines 10-67; col. 2, lines 1-8], and the applicants' specified citation [col. 1, lines 44-49] is not Yamamoto's (U.S. 6,279,587) invention.

f. Applicants argue the solvent 2-N-methyl-pyrrolidone.

See examiner's response to "d" above.

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g. Applicants argue the integration of the pump into the control system.

Applicants broad claim of “control system” is broad enough to include a pump. The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art – *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

h. Applicants argue “... Ihringer (U.S. 4,407,316) does not suggest controlling ... solvent to pass through one filter as opposed to another filter”.

Applicants do not claim “solvent to pass through one filter as opposed to another filter” in a broad sense. Ihringer (U.S. 4,407,316) specifies that the apparatus selectively move the solvents from washing system to recycling system [col. 2, lines 5-9]. Therefore, this meets the limitations stated in claims 8 and 9. Claim 9 does not specify “... solvent to pass through the second filter” but to not pass through the first filter.

i. Applicants further argue the dual filter matter and pump matter in paragraphs 2 and 3 of page 7.

See examiner’s response to “b”, “e”, and “h” above.

j. Applicants argue the use of reference Robb et al. (U.S. Patent 4,793,369).

Robb et al. (U.S. Patent 4,793,369) teaches an alternate alignment of one basin over another. Yamamoto (U.S. Patent 6,279,587) teaches one way of aligning the containers while Robb et al. (U.S. Patent 4,793,369) teaches a different way, thus both are expected to be used with predictable degree of success. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have

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yielded predictable results to one of ordinary skill in the art at the time of the invention –

KSR International Co. v. Teleflex Inc.

k. Applicants arguments to pages 9-10:

See examiner's response above: "a" to "j".

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George D. Bozadjian whose telephone number is 571-270-1871. The examiner can normally be reached on M-F 8:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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GDB


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